#23/Interview Summary 7-24-00 L. Sprull

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:	§	
BILL L. DAVIS and JESSE S. WILLIAMSON	§	
	§	
For Reissue of U. S. Patent 5,630,363	§	Group Art Unit: 2854
Issued May 20, 1997	§	
Serial No 8/515,097	§	
	§	
Filing Date: May 20, 1999	§	Examiner: S. Funk
	§	J. Hilten
	§	
Serial No. 09/315,796	§	
	§	
For: **COMBINED LITHOGRAPHIC/ FLEXOGRAPHIC PRINTING APPARATUS AND PROCESS**	§	

SUMMARY OF INTERVIEW UNDER 37 C.F.R. §1.133

TO: Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

SIR:

On Wednesday, July 19, 2000, Reissue Applicants conducted an interview with Examiner Funk in his office at Crystal Plaza IV. Attending the interview were Reissue Applicants' counsel Robert Hardy Falk, Reissue Applicants' expert Raymond J. Prince, Reissue Applicant Bill Davis, as well as the examiner. Supervisory Examiner Hilten did not attend the interview.

I.

The Examiner was given the opportunity to examine Reissue Applicant Davis on the **JOINT DECLARATION (1) UNDER 37 C.F.R. §1.131 AND (2) PERTAINING TO DERIVATION BY DeMOORE AND PRINTING RESEARCH, INC. OF REISSUE APPLICANTS' INVENTION**, and expert Prince on his **SECOND SUPPLEMENTAL DECLARATION**, both documents submitted on July 7, 2000 by express mail pursuant to Rule 10. While certain portions of these declarations were discussed in general, the Examiner chose not to examine Davis or Prince on their declarations line-by-line.

II.

Reissue Applicants' counsel stressed that for each of four different reasons, U.S. Patent 5,960,713 (hereinafter the "'713" reference) should be removed as a reference.

First, Reissue Applicants' counsel stressed that because of Reissue Applicants' sworn testimony pertaining to derivation as set forth in their aforesaid **JOINT DECLARATION... PERTAINING TO DERIVATION BY DeMOORE AND PRINTING RESEARCH, INC. OF REISSUE APPLICANTS' INVENTION ("JOINT DECLARATION")**, as corroborated by the declarations of Bird (original and supplemental) and Baker submitted on April 7, 2000, the '713 patent must be removed as a reference. Reissue Applicants' counsel pointed to the testimony of Reissue Applicants made in the **JOINT DECLARATION** and in the Baker and Bird declarations (especially the Bird Supplemental Declaration) that the process elements disclosed in Serial Number 08/435,798/EP 741,025 (A2) had been derived from Reissue Applicants in the summer and fall of 1994. Reissue Applicants' counsel reemphasized arguments made in the **SUPPLEMENTAL AMENDMENT UNDER 37 C.F.R. §1.111** submitted under Rule 10 on July 7, 2000 and in particular, *In re Matthew*, 408 F.2d 1393, 161 USPQ 276, 56 CCPA 1033, 1037-8 (CCPA 1969), a copy of which was given to the Examiner, that the derivation testimony is independent and controlling. Reissue Applicants' counsel strenuously maintained, based on *Matthew* that the averments as to derivation made by Reissue Applicants, Baker and Bird, were sufficient to remove the reference, apart from Rule 131 testimony.

Second, Reissue Applicants' counsel indicated that Reissue Applicants had made the necessary averments under 37 C.F.R. §1.131 which were also incorporated in their recent declaration submitted July 7, 2000. For that independent reason, also, the '713 reference should be removed.

Third, Reissue Applicants' counsel indicated that the '713 patent was clearly not entitled to the benefit of the filing date of Serial Number 08/435,798 based on the requirements of law. The Examiner was given a copy of *Tronzo v. Biomet*, 156 F.3d 1154 (Fed. Cir. 1998), and Reissue Applicants' counsel also emphasized the chain of Federal Circuit

cases on page 29 of the Supplemental Amendment. The Examiner was also given a copy of *In re Shaw*, 202 U.S.P.Q. 285, 293 (Comm. of Pat. 1978), which Reissue Applicants' counsel stated indicated clearly that the Examiner not only had the power and authority, but the obligation to review each claim of the '713 patent to determine whether same had 35 U.S.C. §112, first paragraph support in Serial Number 08/435,798, since §112 first paragraph, support was now an issue. Reissue Applicants' counsel emphasized that an analysis under the Federal Circuit case law, e.g., *Tronzo* and *Shaw* had to be made of each of claims 1-26 of the '713 patent for support in Serial number 08/435,798 to ascertain whether or not the '713 patent was entitled properly to the May 4, 1995 filing date, i.e., whether the disclosure in Serial Number 08/435,798 met the three requisites of 35 U.S.C. §112, first paragraph for each of the '713 claims.

Reissue Applicants' counsel emphasized that the answer was clearly in the negative for each of the claims and pointed to the sworn testimony of Expert Prince in his Second Supplemental Declaration, paragraphs 7-14 and in particular paragraphs 11-12. The Examiner was requested to question Expert Prince, particularly on paragraphs 11-12 if he had any problems with that testimony. The Examiner did not question Prince on Prince's testimony in paragraphs 11-12.

Reissue Applicants' counsel indicated that only recently had he been able to obtain a copy of the file wrapper of Serial Number 08/435,798, and that it was Reissue Applicants' position that none of the claims of that application were patentable. Reissue Applicants disclosed that the majority of the Serial Number 08/435,798 claims were still under rejection before the Board of Appeals as of early June 2000 when the file wrapper was received, but about six narrow claims had been allowed Reissue Applicants' counsel maintained that any patent issuing from Serial Number 08/435,798 could be removed by the same **JOINT DECLARATION** and the Bird and Baker Declarations. In any event, all of the prior art and other information disclosed in Serial Number 08/435,798 was being brought to the attention of the instant Examiner.

In the declaration Expert Prince very carefully and in great detail pointed out that '713 and '798 were two different devices that taught different technology and that '713 should not be given the benefit of the earlier date of '798. Expert Prince questioned how the Examiner read the Prince declaration regarding this point. The Examiner stated that he did not care that the two items were different "since the Patent Office interprets claims for [§120 entitlement] support in the broadest sense." Expert Prince took exception and stated again that the two patents, namely the '713 patent and the '798 application, are entirely different in mechanics, as well as teaching. Expert Prince also pointed out that some of the teachings of the '713 patent were inoperable. Reissue Applicants' counsel stated that the Examiner's understanding of the law was clearly incorrect under *Tronzo* and its predecessors in the Federal Circuit and CCPA and under *Shaw*, and that each '713 claim had to be examined, limitation by limitation, for §112 support in Serial Number 08/435,798.

Fourth and last, Reissue Applicants' counsel indicated that the '713 patent should be removed as a reference apart from the evidence as to derivation/Rule 131 averments/no §112, first paragraph support 08/435,798, as the '713 patent was improperly and illegally issued. Reissue Applicants' counsel pointed out that in his copy of the filing of the '713 patent DeMoore et al. did not provide an oath for the August 19, 1998 continuation-in-part of coapplicant Bird nor was there any indication whatsoever in Reissue Applicants' copy that, under Rule 47 Bird had refused to execute the continuation-in-part application at that time or even that any attempt had been made to reach him. Second, Reissue Applicants' counsel indicated that there was no indication in his copy of the '713 patent that any of the published foreign counterparts to Serial Number 08/435,798 or of the foreign counterparts of Serial Number 08/538,422 had been identified in the continuation-in-part August 1998-filed oath and that the very foreign publication improperly invoked by the Examiner in his February 9, 2000 first office action, EP 741,025 (A2) -- published in the fall of 1996 -- had not been brought to the attention of the '713 examiner. Absent a proper oath, Reissue Applicants' counsel maintained, there was no proper examination. Examiner Funk was also informed that the column 16 addition to the '713 patent outlines 17-41 was clearly made in response to a final

office action in Serial Number 08/538,422 and that the examiner of the application leading to the '713 patent should have been informed about EP 741,025 (A2) and the other published foreign counterparts. Examiner Funk was also informed that the '713 examiner had not been told, as reflected by the file wrapper of the '713 patent, of Reissue Applicants' '363 patent until the '713 issue fee was paid in March 1999, despite the fact that the '713 counsel admitted that his clients knew about the '363 patent since December 1998 or January 1999. Reissue Applicants' counsel indicated that a patent clearly improperly granted with a defective oath and defective examination could not be employed as a §102(e) bar to anything and, for that reason alone, apart from the other reasons, the '713 rejection should be removed.

The Examiner indicated that he would review the **JOINT DECLARATION**, the Prince Supplemental Declaration, the Supplemental Amendment, and Reissue Applicants' cited case law before making a decision, but indicated that the Declaration of Reissue Applicants as to derivation and Rule 131 might make such a *Tronzo*-type comparison moot.

III.

Reissue Applicants' counsel also stressed that the new claims to the Reissue Application 42-87 as to perfecting were well supported by the specification based on the language of "perfecting" at column 2, second the various references to printing "over" mentioned in the specification, and the multiplicity of references to a "continuous in-line printing process." Expert Prince explained two items:

(a) The word "over" as it applies to "perfecting"; and

(b) The definition of "continuous in-line manufacturing".

Concerning the word "over", Examiner Funk conceded the point that "over" can encompass the word "perfecting". Examiner Funk conceded that the rejection under 35 U.S.C. §112, first paragraph and 35 U.S.C. §251, fourth paragraph of new claims 42-87 should be removed but did not indicate whether or not he would maintain any of the 35 U.S.C. §§ 102-103 rejections in view of the '713 patent, indicating that he would have to review Reissue Applicants' recent Supplemental Amendment in order to ensure that all the requested objections and rejections under 35 U.S.C. §112 had been cured.

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IV.

Reissue Applicants' counsel requested that the Examiner review carefully **REISSUE APPLICANTS' MEMORANDUM CONCERNING THE PRIOR ART AND THEIR POSITION ON PATENTABILITY** submitted April 7, 2000 and separately each of the pieces of prior art and other information submitted in Reissue Applicants' original disclosure statement and their two subsequent disclosure statements, and execute the appropriate PTO 1449 forms.

V.

Reissue Applicants also tendered to the Examiner a copy of a letter sent by facsimile on July 18, 2000 from Reissue Applicants' counsel to protestors' counsel Harris requesting Harris to identify any of protestors' documents produced by protestors in the Northern District of Texas believed by protestors to be material to the examination of the instant application. Reissue Applicants' counsel indicated that he did not believe any of protestors' documents to be material under Rule 56(a).

Respectfully submitted,

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CERTIFICATE OF SERVICE

This is to certify that the foregoing Summary of Interview Under 37 C.F.R. §1.133 was served on '363 Protestors counsel of record by placing a true and correct copy in the United States mail, postage prepaid, on the 21 day of July, 2000, addressed as follows:

William D. Harris, Jr., Esq.
Locke Liddell & Sapp L.L.P.
2200 Ross Avenue, Suite 2200
Dallas, Texas 75201-6776

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*** TX REPORT ***
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FROM: Robert Falk
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FAX NUMBER: 214-740-8800

CONFIRMATION NUMBER: 214-740-8000

DATE: July 18, 2000

TOTAL PAGES (Including cover) 2

- M E S S A G E -

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July 20, 2000

VIA FEDERAL EXPRESS

Examiner Stephen Funk
United States Patent and Trademark
Office Group 2854
Room 9D35 - Crystal Plaza IV
Arlington, VA 22202

Re. *Bill L. Davis, et al.*; United States 09/315,796;
Our File No. Will 2501

Dear Examiner Funk:

As promised, enclosed is our Rule 133 Interview Summary. I am informed that Reissue Applicant Davis is going to be sending you some materials on perfecting and additionally a graphic comparison of the advantages of this invention over the prior art.

Very truly yours,

Robert Hardy Falk

RHF/jc
Enclosure
cc: John Pinkerton

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FACSIMILE COVER LETTER

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PLEASE DELIVER THE FOLLOWING PAGES TO:

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SPECIAL INSTRUCTIONS

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